

## **REMARKS**

Re-examination and further consideration of the subject reissue patent application, in view of the foregoing amendments and accompanying remarks, are respectfully requested.

The outstanding Official Action is broken down into three categories: Drawings, Claim Rejections – 35 USC §112 and Reissue Applications (35 USC 251). Each of these categories will be addressed in detail in the order they appear in the Official Action.

### **DRAWINGS**

In the outstanding Official Action, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference number 22. Attached hereto is a copy of Applicants' previous submission of drawing amendments filed on or about September 3, 1999 in which Applicants' propose new Figures 2a and 2b. Proposed new Fig. 2b is the same as original Fig. 2. Fig. 2a is added to show the energy director element 22 to overcome the objection to the drawings under 37 CFR 1.84(p)(5). Per the statement in the Official Action, this page has now been labeled "Replacement Sheet."

The Examiner has objected to the proposed replacement sheet of drawings on the grounds that it introduces new matter into the drawings. In particular, the Examiner asserts that the original disclosure does not provide sufficient support for an energy director 22 which forms a v-shaped groove in the surface of a frame element. Applicants respectfully submit that this objection/rejection is not proper.

The original drawing clearly shows a lower energy director 20 that extends upward in a v-shaped fashion along the upper surface of the lower frame element 18 (See Fig. 2 of the original patent). The specification of the patent further describes:

A corresponding energy director element 22 extends along one half of the lower perimeter surface of the upper frame element 16. These energy directors 20 and 22 mate with corresponding frame surface to form the well during the sonic welding process. See Col. 3, lines 14-19.

Based on this written description of outwardly projecting V-shaped energy director 20 (Fig. 2) that mates with the other energy director 22, those skilled in the art would clearly recognize that the corresponding energy director 22 must be a groove as show in the proposed drawings (Fig. 2a.) Accordingly, Applicants respectfully submit that the proposed drawing is not new matter.

While it is true that the original disclosure and drawings do not depict the v-shaped groove for mating with v-shaped projection that is disclosed, one of ordinary skill in the art based upon what is specifically disclosed in the written description would understand that in order to mate with the v-shaped projection on the surface of the lower frame element 18, the energy director element 22 and the upper frame element 16 would have to have a complimentary v-shaped groove. If energy directors 20 and 22 were not of the same shape, they could not mate.

Webster's Ninth New Collegiate Dictionary defines mate as "to join or stick together." One skilled in the art, reviewing Applicants' disclosure including the depiction of energy director 20 in Fig. 2 and the specification that states energy director 22 should mate with energy director 20, would be led to the conclusion that the energy director 22 must take the shape of a v-shape groove as illustrated in Fig. 2a. Applicants respectfully submit that this is clear and the addition of the groove to the figures of drawing as set forth in proposed Fig. 2a is not new matter as it is based upon the written description in the original patent specification. Therefore, Applicants respectfully request that the rejection/objection to the proposed drawings be withdrawn and that Figs. 2a and 2b be substituted for Fig. 2 in the original patent.

#### CLAIM REJECTIONS – 35 USC §112

In the outstanding Official Action the Examiner has rejected claims 7-14, 16-20 and 22-28 under 35 USC §112, first paragraph, as reciting subject matter which is not described

in the specification in such a way as to reasonably convey to one of skill in the relevant art that the inventors at the time that the application was filed had possession of the claimed invention. The Examiner provides specific grounds for this rejection with respect to claims 7, 9, 11, 16-18 and 22-28. By the foregoing amendments, Applicants have cancelled claims 17, 18, 22, 23 and 25-27, rendering the rejection of those claims moot. In addition, Applicants have amended claims 9 and 16 to delete the term “at least” thereby rendering the rejection of those claims moot. This leaves only claims 7, 11, 24 and 28 subject to the rejection under 35 USC §112, first paragraph. For the reasons which follow, the Examiner is respectfully requested to reconsider and withdraw this rejection with respect to these claims.

CLAIM 7

Claim 7 recites, in part, “each cover having a first side and second side with at least one finger extending from each of said sides.” In the outstanding Official Action, the Examiner asserts that the recitation of at least one finger on each of the sides constitutes new matter. The Examiner argues that the original disclosures teaches providing the first and second sides of the metal covers with multiple fingers and that there is no suggestion of using only one finger on each of the first and second sides.

Applicants respectfully submit that the specification provides support for claim 7 because it discloses an embodiment of the invention with at least one finger on each of the two sides of the covers. For example, Fig. 3 clearly illustrates the embodiment with at least one finger extending from each of the two sides of the cover. The specification provides adequate support because the claim reads directly on the disclosed embodiment and, therefore, there clearly is no issue of new matter.

The fact that the claim is broader than the specific embodiment shown in the specification does not raise an issue of new matter. Both the Federal Circuit and its predecessor have expressly approved claims that are broader than the specific embodiments

in the specification; even when those claims are presented for the first time in a reissue application. See, *In re Rasmussen*, 211 USPQ at 326; *In re Peters*, 221 USPQ at 952.

Indeed, in view of the disclosure and applicable case law, the only rationale for the rejection is an Examiner-imposed requirement that the disclosure show an objective intent to claim the invention as now claimed. However, the Federal Circuit has expressly rejected the “intent to claim” standard. See, *Hester Industries Inc. v. Steinin*, 46 USPQ2d at 1641, 1651 (Fed. Cir. 1998). Rather, the issue is whether the claims read on the disclosure and there can be no question but that the present claims read directly on the disclosure provided in the original patent. Thus, claim 7, as amended, is adequately supported by the specification and the fact that the claims are broader than the particular embodiment shown in the specification is irrelevant. Accordingly, the rejection of claim 7 under 35 USC §112, first paragraph, should be withdrawn.

#### CLAIM 11

Claim 11 recites, in part, “at least one finger extending from each of said sides of said cover.” Here again, the Examiner has taken the position that the recitation of “at least one finger” raises the issue of new matter for the same reasons as set forth with respect to claim 7.

Applicants respectfully submit for the same reasons given with respect to claim 7, the rejection of claim 11 is, likewise, not warranted and should be withdrawn.

#### CLAIM 24

Claim 24 claims edges including fingers and describes the metal covers having edges bent to conform to the shape of the frames. The Examiner has rejected this claim as not being supported by the specification because it reads on 1, 3 or all edges being bent or 1, 3 or sides having fingers which, according to the Examiner, is not shown or described in the specification. This rejection is respectfully traversed.

There is no requirement in the law that the claims must be limited to the specific disclosed embodiment. The specification and drawings in the subject application clearly disclose edges including fingers and the metal covers having edges bent to conform to the shape of the frame. This is what is being claimed in claim 24. The Examiner is, therefore, requested to reconsider and withdrawn this rejection of claim 24.

#### CLAIM 28

Claim 28 claims a cover having two edges bent generally in a U-shape with each of the edges including protruding portions adjacent open portions providing voids. The frame elements have injection molded portions with the U-shape edges of the covers and the injection molded portions are contained within at least one of the voids on the edges of the covers in order to provide an integral unit. These protruding portions and voids are clearly shown in the original drawings. Accordingly, the language of claim 28 is supported by the specification.

The Examiner asserts that in the language of claim 28 reads on, for example, “an end surface of each of the edges having a plurality of spaced-apart small spherical bulbs projecting from the end surface” and as this structure is not disclosed in the application, the claim raises the issue of new matter.

Applicants respectfully submit that the Examiner is applying the wrong standard in determining the enablement of the specification to the claims. It has never been the law that the specification must disclose each and every possible embodiment encompassed by the claims. Yet, this is the standard that the Examiner is imposing in making this rejection. The fact remains that the language of claim 28 reads directly on the embodiment described and illustrated in the specification and, therefore, the language of that claim is fully supported and in compliance with the requirements of 35 USC §112, first paragraph. Accordingly, the Examiner is requested to reconsider and withdraw this rejection.

With respect to all rejections of the claims under 35 USC §112, first paragraph, it must be recognized that the burden is on the Examiner to present evidence demonstrating why those skilled in the art would not recognize from the specification a description of the claimed invention. *In re Voss*, 194 USPQ at 271. The Examiner, it is respectfully submitted, has not done so in this case. On the other hand, Applicants have submitted evidence in support of their position. Applicants previously submitted the Declaration of James R. Wingfield, an adjunct professor at the Illinois Institute of Technology in the Department of Mechanical Aerospace Engineering. A copy of this previously submitted Declaration is attached for the Examiner's convenience. As described in ¶¶ 5, 7 and 9 of the Declaration, Mr. Wingfield has concluded that based on his review of the original disclosure, the inventors had possession of the features described in the claims in issue in this reissue application.

In particular, as described by Mr. Wingfield, the specification of the patent shows that the inventors had possession of a package having one or more fingers extending from the sides of the cover. Wingfield Declaration ¶5. Further, as described by Mr. Wingfield, the inventors had possession of the package in which the edges of the covers are formed into a U-shaped edge (as shown in Figure 4), and then a frame element is injection molded with the U-shaped edge of the metal cover. Wingfield Declaration ¶7. Further, the specification establishes that the inventors had possession of a package in which the fingers are partially or fully injection molded into the plastic frame elements. Wingfield Declaration ¶9. These statements by Mr. Wingfield demonstrates that one of ordinary skill in the art, reading the specification, would identify the subject matter of the amended claims as being invented and disclosed by Applicants in the original specification. Accordingly, Applicants respectfully submit that they have more than adequately rebutted the Examiner's rejections of the claims under 35 USC §112, first paragraph and that this rejection should be withdrawn.

REISSUE APPLICATIONS (35 USC §251)

The Examiner has rejected 7-14, 16-20 and 22-28 under 35 USC §251, as being an improper recapture of subject matter surrendered in the application for patent upon which the present reissue is based. In its decision dated August 1, 2003, the Board of Patent Appeals and Interferences remanded the subject reissue application to the Examiner with specific instructions to review this rejection in view of the decision in Ex Parte Eggert 67 USPQ2d 1716. In the outstanding Official Action, the Examiner has apparently taken the position that the Ex Parte Eggert decision does not warrant withdrawal of this rejection. Applicants respectfully submit that a proper reading of Eggert demonstrates that the claims which are presently pending in the application, after entry of the foregoing amendments, are not subject to rejection on the grounds of improper recapture.

In Ex Parte Eggert, the Board made it absolutely clear that it refused to apply a per se rule that after a limitation is added to a claim or argued to be significant in distinguishing a claim over prior art applied in a rejection, any reissue claim which does not contain that limitation is per se impermissible. Ex Parte Eggert at 1718. Rather, the Board held that a claim which is broader in scope than the issued claim but narrow in scope than the rejected claim in the prosecution of the patent, is properly the subject for a broaden reissue and is not subject to the recapture rule. The Board recognized in its decision:

In the present case Applicants believe that in further amending claim 1 (once amended) in an attempt to define patentable subject matter, they, in essence, over shot the mark in marrying the claim by using language added to claim 1 (twice amended), i.e., that they claimed less matter right to claim, and that they now wish to “retreat” back from the inner circle shown in drawing 1 into the shaded area between the circles in a further attempt to define alternative patentable subject matter.

Ex Parte Eggert at 1717.

The Board held that it is entirely appropriate to amend the claims in this manner and not subject to a recapture rejection. This is precisely what Applicants are attempting to do in the present application. By comparing the scope of the claims, as presently amended, in the reissue application to the claims which were rejected in the prosecution of the patent and the claims that were finally issued in the patent, it is evident that the present claims while broader than the issued claims are narrower than the finally rejected claims and, therefore, fall within the gray “donut” area of the drawing used by the Board in the Eggert case to illustrate the permissible scope of broaden reissued claims.

Attached hereto too is a copy of claim 16 from the prosecution history of the original patent as finally rejected. Also attached is the Examiner’s Amendment from the prosecution history of the patent showing how claim 16 was amended to become issued claim 1 in the subject patent. Issued claim 1 and finally rejected claim 16, define the boundary for permissible broadening by reissue. A comparison of independent claim 7, 11, 24 and 28 pending in the present application to rejected claim 16 in the prosecution of the patent shows that none of the pending claims are broader in scope than rejected claim 16. These claims, therefore, fall within the gray area between the scope of the issued claim and the scope of the rejected claim and, as the Board held in Ex Parte Eggert, are properly the subject of a broaden reissue application.

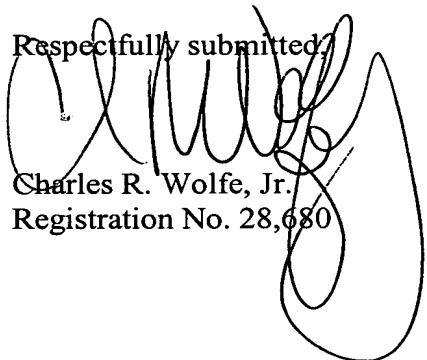
In the outstanding Official Action, the Examiner has identified Elements 1-6 as limitations relied upon to obtain allowance of the patent claims. However, as the previously quoted statements of the Board in the Ex Parte Eggert case indicate, the removal of limitations that were argued as a basis for patentability in a reissue claim does not amount to an improper recapture so long as the scope of the claims remains narrower than the scope of the rejected claim. Applicants are entitled to seek via reissue a remedy for “overshooting” the mark when they amended the claims during the prosecution of the patent to distinguish



over the prior art. Accordingly, as the claims presently before the Examiner after entry of the amendments presented in this paper are of narrower scope than the rejected claim 16 in the prosecution of the patent, these claims are not subject to rejection under the recapture rule. Accordingly, the Examiner is requested to reconsider and withdraw the rejection of the claims on this ground.

In view of the foregoing amendments to the claims and the accompanying remarks, Applicants respectfully submit that further favorable action in the form of a Notice of Allowance is now in order and such action is most earnestly solicited.

Respectfully submitted,

  
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Attachments

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